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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/688,495

10/17/2003

Bruce A. Mosley

2301-M

1974

22932

7590

11/15/2006

IMMUNEX CORPORATION  
LAW DEPARTMENT  
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SEATTLE, WA 98119

EXAMINER

XIE, XIAOZHEN

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/688,495

Applicant(s)

MOSLEY ET AL.

Examiner

Xiaozhen Xie

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 and 27 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendments of the specification and the claims received on 1 September 2006 have been entered.

### ***Election/Restrictions***

Applicant confirms the election of Group II, claim 9, with traverse, in the response received on 1 September 2006.

The traversal is on the ground(s) that the subject matter of each of Groups I and II is defined with reference to polypeptides comprising or consisting of certain specified fragments of particular IL-4R polypeptide sequences, and thus, a search of both groups will require scarcely more effort than a search of either one of them. This is not found persuasive because the elected claims themselves contain several components, as well as both products and methods of use, which must be individually searched. A search and examination of additional method of Group I in one patent application would result in an undue burden, since the searches for these methods are not co-extensive, the classification is different, and the subject matter is divergent.

The requirement is still deemed proper and is therefore made FINAL. Claims 1-9 are pending. Claims 1-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claim 9 is under examination.

### ***Claim Rejections Withdrawn***

The objection of the specification for failing to update cross-reference to related applications is withdrawn in response to Applicant's amendment of the specification.

The objection of the abstract for failing to describe the claimed invention is withdrawn in response to Applicant's amendment of the abstract.

The rejection of claim 9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is withdrawn in response to Applicant's amendment of the claim.

The rejection of claim 9 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, is withdrawn in response to Applicant's amendment of the claim.

***Claim Rejections Maintained/New Grounds of Rejections***

Claim 9 remains rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1 and 3 of U.S. Patent 5,717,072, for reasons set forth in the previous office action. Applicant has indicated submission of a Terminal Disclaimer when the claims have been found otherwise allowable.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claim is directed to non-statutory subject matter. Because they do not require that the antibody be isolated, they encompass products of nature, which are not patentable. This rejection could be overcome by addition of the limitation wherein the antibody is isolated.

**Conclusion**

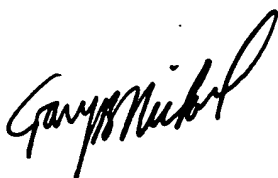
NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xiaozhen Xie whose telephone number is 571-272-5569. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary B. Nickol, Ph.D. can be reached 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Xiaozhen Xie, Ph.D.  
October 31, 2006



GARY B. NICKOL, PH.D.  
SUPERVISORY PATENT EXAMINER  
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